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10/633,020	07/31/2003	Carl Smith	VISAP076	4731
75458	7590	01/10/2008		
Beyer Weaver LLP/Visa P.O. Box 70250 Oakland, CA 94612-0250			EXAMINER COLAN, GIOVANNA B	
			ART UNIT 2162	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/633,020

**Applicant(s)**

SMITH ET AL.

**Examiner**

Giovanna Colan

**Art Unit**

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/12/2004, 02/13/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is issued in response to applicant filed request for continued examination (RCE) on 10/29/2007.
2. Claims 1, and 11 have been amended. No claims were added. Claims 21 – 35 were canceled.
3. Claims 1 – 20 are pending in this application.

### ***Response to Arguments***

4. Applicant's arguments with respect to amended claims 1, and 11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Continued Examination Under 37 CFR 1.114***

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/11/2006 has been entered.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tushie et al. (Tushie hereinafter) (US Patent No. 6,014,748), in view of Harms et al. (Harms hereinafter) (US Patent No. 6,070,147), and further in view of Anderson et al. (Anderson hereinafter) (US 5,884,289).

Regarding Claim 1, Tushie discloses a method for automating the personalization of a batch of smart cards (Col. 5 and 6, lines 66 – 67 and 1 – 5, Tushie), comprising:

executing a personalization assistant tool (Col. 2, lines 38 – 40, Tushie), said software tool including a default member profile having default values for smart card features (Col. 2 and 18, lines 39 – 40 and 5 – 24, “The card framework template record describes the structure of the chip on the card. In the sample shown below, the \$MF entry defines a root directory (3F00), while \$DF entries define a medical application (5F20), and an accounting application (5F10). Within each directory are application-specific files defined by \$EF entries, such as 6F00 containing the account name and 6F10 containing the account number. All file descriptive data resides in the card framework template and is referenced at various times during the smart card issuing process”, wherein the card framework template record corresponds to the default member profile claimed; and wherein entries, such as, account name and account number correspond to the default values for smart card features; Tushie);

Furthermore, Tushie also discloses a method and system for receiving smart card feature information (Page 6, lines 40 – 46, Tushie) that was previously entered into a cardholder database management system by a user (Fig. 1B, item 152, Page 7, lines 48 – 59, Tushie). In addition, Tushie discloses that the smart card personalization system will create smart cards according to the information received from alternate inputs (Col. 6, lines 54 – 56, Tushie) and from a software tool (Fig. 1A, item 150, Card Issuer Mgmt System, Page 9, lines 23 – 26 and 33 – 38; respectively, Tushie). However,

Tushie is silent with respect to the details on how the user enters such smart card information into the system. On the other hand, Harms discloses computer instructions for providing a user with a plurality of queries regarding said smart card features (Col. 5, lines 17 – 24 and 36 – 40; respectively, “the retail clerk (or consumer) can manually key-in the desired information from the card by following prompts displayed by the identification terminal, Harms), said queries originating from said software tool (Col. 5, lines 1 – 5; “ ...the identification terminal 15 could be integrated into a single reader...”, Harms); receiving from the user responses to the plurality of queries, said responses being received by said software tool (Col. 5, lines 17 – 24 and 49 – 51, “... the identification information gathered by the identification terminal 15...”, Harms<sup>1</sup>); matching each of said responses with an output data value, said matching being performed by said software tool (Col. 9, lines 41 – 46; Harms). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Harms as a method for users to enter personalized information in the Tushie system at Fig. 1B, item 152, Card Holder Data, to the smart card personalization system of Tushie. Skilled artisan would have been motivated to do so, as suggested by Harms (Col. 3, lines 44 – 45, Harms), to provide a customer-friendly and sustainable approach.

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<sup>1</sup> To further clarify, see for example Harms, Col. 5, lines 36 – 40, “the retail clerk (or the consumer) can manually key-in the **desired information from the card** by following prompts displayed by the terminal”. Wherein it is clear from this paragraph that “the desired information” being entered is information from “the card”; thus it is in regards to smart card features.

The Tushie in view of Harms combination (Tushie/Harms hereinafter) also discloses:

modifying said default member profile using said matched output data values (Col. 9, lines 40 – 50, wherein the record corresponds to the default member profile claimed; and wherein the step of updating the record with the new transaction corresponds to the step of modifying as claimed; Harms); and

generating a personalization data file from a plurality of modified default member profiles (Fig. 5, “Joe Smith” and “Kathleen King”, Col. 7, lines 3 – 11; wherein the Figure shows plurality of modified default member profiles for two consumers for example, “Joe Smith” and “Kathleen King” Harms) and a plurality of sets of said output data values (Col. 7 and 9, lines 11 – 21 and 61 – 67; respectively Harms), wherein the plurality of sets of said output data values used to generate said personalization data file is used to provide said smart card features on each smart card in said batch of smart cards for a plurality of users wherein said batch of smart cards is personalized with respect to the plurality of users (Col.6 and 9, lines 42 – 47 and 33 – 38; respectively, “... The smart card personalization system 100 receives data from a card issuer management system 150 (typically proprietary to the card issuer), translates the data into a data stream, and outputs the data stream to personalization equipment 130 which personalizes the smart cards 160...”; Tushie; and Col. 5, lines 41 – 47, Harms).

Furthermore, Tushie/Harms discloses: said smart cards features including account feature data associated with account (Col. 4, lines 30 – 41, Harms) and low-value payment feature for rapid transaction processing (Col. 12, lines 3 – 9, Harms).

However, Tushie/Harms does not explicitly disclose that said smart card features include account usage, and authorization control feature data providing instructions relating to risk management ([57], Abstract, Anderson). On the other hand, Anderson discloses smart card features including: account feature data associated with account usage, and authorization control feature data providing instructions relating to risk management checks. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Anderson's teachings to the system Tushie/Harms. Skilled artisan would have been motivated to do so, as suggested by Anderson ([57], Abstract, Anderson), to identify "at risk" cards in the criminal's possession which have not yet been used, and to limit the losses to individual financial institutions and the financial institution community at large.

Regarding Claim 2, the Tushie in view of Harms and further in view of Anderson combination (Tushie/Harms/Anderson hereinafter) discloses a method, further comprising using individual cardholder input files and the personalization data file to personalize a plurality of smart cards to yield a plurality of personalized smart cards (Col. 2, lines 46 – 54, Tushie; and Col. 4, and 5, lines 47 – 54 and 49 – 51; respectively, Harms).

Regarding Claim 3, Tushie/Harms/Anderson discloses a method, wherein the generating a personalization data file, comprises:

providing a look up table with entries for various combinations of responses to the plurality of queries (Fig. 5, Col. 9, lines 36 – 41, Harms);

finding a matching entry in the look up table that matches the responses to the plurality of queries (Fig. 5, Col. 9, lines 41 – 45, Harms);

locating personalization data file output associated with the matching entry (Fig. 5, Col. 9, lines 41 – 45, Harms); and

outputting the personalization data file output associated with the matching entry (Col. 11, lines 50 – 55, Harms).

Regarding Claim 4, Tushie/Harms/Anderson discloses a method, wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control (Col. 4, lines 30 – 41, Harms; and [57], Abstract, Anderson);

at least one query regarding smart card account risk management ([57], Abstract, Anderson); and

at least one query regarding offline limits and thresholds (Col. 5, lines 19 – 24, Harms).

Regarding Claim 5, Tushie/Harms/Anderson discloses a method, wherein responses to the plurality of queries are used to provide best practices recommendations (Col. 11, lines 45 – 50, Harms).

Regarding Claim 6, Tushie/Harms/Anderson discloses a method, further comprising providing regional profiles and subregional profiles, wherein a subregion is within a region, wherein the regional and subregional profiles have mandatory and recommended settings, wherein some of the subregional profiles are more stringent than regional profiles in which the subregions belong (Col. 7, lines 14 – 21 and 58 – 63, Harms).

Regarding Claim 7, Tushie/Harms/Anderson discloses a method, wherein the generating a personalization data file, comprises:

providing a look up table with entries for various combinations of responses to the plurality of queries (Fig. 5, Col. 9, lines 36 – 41, Harms);

finding a matching entry in the look up table that matches the responses to the plurality of queries (Fig. 5, Col. 9, lines 41 – 45, Harms);

locating personalization data file output associated with the matching entry (Fig. 5, Col. 9, lines 41 – 45, Harms); and

outputting the personalization data file output associated with the matching entry (Col. 11, lines 50 – 55, Harms).

Regarding Claim 8, Tushie/Harms/Anderson discloses a method, wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control (Col. 4, lines 30 – 41, Harms; and [57], Abstract, Anderson);

at least one query regarding smart card account risk management ([57], Abstract, Anderson); and

at least one query regarding offline limits and thresholds (Col. 5, lines 19 – 24, Harms).

Regarding Claim 9, Tushie/Harms/Anderson discloses a method, further comprising computer instructions for using responses to the plurality of queries to provide best practices recommendations (Col. 11, lines 45 – 50, Harms).

Regarding Claim 10, Tushie/Harms/Anderson discloses a method, further comprising providing regional profiles and subregional profiles, wherein a subregion is within a region, wherein the regional and subregional profiles have mandatory and recommended settings, wherein some of the subregional profiles are more stringent than regional profiles in which the subregions belong (Col. 7, lines 14 – 21 and 58 – 63, Harms).

Regarding Claim 11, Tushie/Harms/Anderson discloses a computer implemented method for automating the personalization of a batch of smart cards (Col. 5 and 6, lines 66 – 67 and 1 – 5, Tushie), comprising:

running on a host computer a personalization assistant software application (Col. 2 and 6, lines 38 – 40 and 57 – 58; respectively, Tushie), said software application including a default member profile having default values for smart card features (Col. 2

and 18, lines 39 – 40 and 5 – 24, “The card framework template record describes the structure of the chip on the card. In the sample shown below, the \$MF entry defines a root directory (3F00), while \$DF entries define a medical application (5F20), and an accounting application (5F10). Within each directory are application-specific files defined by \$EF entries, such as 6F00 containing the account name and 6F10 containing the account number. All file descriptive data resides in the card framework template and is referenced at various times during the smart card issuing process”, wherein the card framework template record corresponds to the default member profile claimed; and wherein entries, such as, account name and account number correspond to the default values for smart card features; Tushie), said smart card features including account feature data associated with account usage (Col. 4, lines 30 – 41, Harms; and [57], Abstract, Anderson), authorization control feature data providing instructions relating to risk management checks ([57], Abstract, Anderson), and a low-value payment feature for rapid transaction processing (Col. 12, lines 3 – 9, Harms);

providing to at least one user system over a network a plurality of queries regarding smart card features (Col. 5, lines 17 – 24, Harms), said queries originating from said software application (Col. 5, lines 1 – 5; “...the identification terminal 15 could be integrated into a single reader...”, Harms, and also see - Col. 5, lines 17 – 24 and 36 – 40; respectively, “the retail clerk (or consumer) can manually key-in the desired information from the card by following prompts displayed by the identification terminal, Harms);

receiving from the at least one user system over the network responses to the plurality of queries, said responses being received by said software application tool (Col. 5, lines 17 – 24 and 49 – 51, "... the identification information gathered by the identification terminal 15...", Harms<sup>2</sup>);

matching each of said responses with an output data value, said matching being performed by said software tool (Col. 9, lines 41 – 46; Harms);

modifying said default member profile using said matched output data values (Col. 9, lines 44 – 50, Harms); and

generating a personalization data file from said default member profile and said output data values (Col. 9, lines 61 – 67, Harms), wherein the output data values of said personalization data file is used to provide said smart card features on said batch of smart card when said batch of smart cards is personalized (Col. 9, lines 33 – 38, Tushie; and Col. 5, lines 41 – 47, Harms).

Regarding Claim 12, Tushie/Harms/Anderson discloses a computer implemented method, further comprising:

sending the personalization data file to a preparation processing device (Fig. 1A, item 100 and 150, Col. 6, lines 42 – 46, Tushie; and Col. 6, lines 32 – 35, Harms);  
and

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<sup>2</sup> To further clarify, see for example Harms, Col. 5, lines 36 – 40, "the retail clerk (or the consumer) can manually key-in the **desired information from the card** by following prompts displayed by the terminal". Wherein it is clear from this paragraph that "the desired information" being entered is information from "the card"; thus it is in regards to smart card features.

using the personalization data file and cardholder input files to personalize smart cards (Fig. 1A, items 130 and 160, Col. 6, lines 45 – 47, Tushie).

Regarding Claim 13, Tushie/Harms/Anderson discloses a computer implemented method, wherein the generating a personalization data file, comprises:

providing a look up table with entries for various combinations of responses to the plurality of queries (Fig. 5, Col. 9, lines 36 – 41, Harms);

finding a matching entry in the look up table that matches the responses to the plurality of queries (Fig. 5, Col. 9, lines 41 – 45, Harms);

locating personalization data file output associated with the matching entry (Fig. 5, Col. 9, lines 41 – 45, Harms); and

outputting the personalization data file output associated to the matching entry (Col. 11, lines 50 – 55, Harms).

Regarding Claim 14, Tushie/Harms/Anderson discloses a computer implemented method, wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control (Col. 4, lines 30 – 41, Harms; and [57], Abstract, Anderson);

at least one query regarding smart card account risk management ([57], Abstract, Anderson); and

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at least one query regarding offline limits and thresholds (Col. 5, lines 19 – 24, Harms).

Regarding Claim 15, Tushie/Harms/Anderson discloses a computer implemented method, wherein responses to the plurality of queries are used to provide best practices recommendations (Col. 11, lines 45 – 50, Harms).

Regarding Claim 16, Tushie/Harms/Anderson discloses a computer implemented method, further comprising providing regional profiles and subregional profiles, wherein a subregion is within a region, wherein the regional and subregional profiles have mandatory and recommended settings, wherein some of the subregional profiles are more stringent than regional profiles in which the subregions belong (Col. 7, lines 14 – 21 and 58 – 63, Harms).

Regarding Claim 17, Tushie/Harms/Anderson discloses a computer implemented method, wherein the generating a personalization data file, comprises:

providing a look up table with entries for various combinations of responses to the plurality of queries (Fig. 5, Col. 9, lines 36 – 41, Harms);

finding a matching entry in the look up table that matches the responses to the plurality of queries (Fig. 5, Col. 9, lines 41 – 45, Harms);

locating personalization data file output associated with the matching entry (Fig. 5, Col. 9, lines 41 – 45, Harms);

and

outputting the personalization data file output associated to the matching entry (Col. 11, lines 50 – 55, Harms).

Regarding Claim 18, Tushie/Harms/Anderson discloses a computer implemented method, wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control (Col. 4, lines 30 – 41, Harms; and [57], Abstract, Anderson);

at least one query regarding smart card account risk management ([57], Abstract, Anderson); and

at least one query regarding offline limits and thresholds (Col. 5, lines 19 – 24, Harms).

Regarding Claim 19, discloses a computer implemented method, wherein responses to the plurality of queries are used to provide best practices recommendations (Col. 11, lines 45 – 50, Harms).

Regarding Claim 20, the Tushie in view of Harms combination discloses a computer implemented method, further comprising providing regional profiles and subregional profiles, wherein a subregion is within a region, wherein the regional and subregional profiles have mandatory and recommended settings, wherein some of the

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subregional profiles are more stringent than regional profiles in which the subregions belong (Col. 7, lines 14 – 21 and 58 – 63, Harms).

***Prior Art Made Of Record***

1. Tushie et al. (US Patent No. 6,014,748) discloses a system and apparatus for smart card personalization.
2. Tommy J. Morris (US Patent Pub. Application No. 2004/0078227 A1) discloses a system and method for handling medical information.
3. Tommy J. Morris (Provisional US App. No. 60/381,058).
4. Harms et al. (Harms hereinafter) (US Patent No. 6,070,147).
5. Hamann et al. (US Patent No. 6,729,549 B2) discloses a system and method for personalization of smart cards.
6. Handel et al. (US Patent N. 6,195,651 B1) disclose a system, method and article of manufacture for a tuned user application experience.
7. Bessette (US Patent No. 6,263,330 B1) discloses a method and apparatus for the management of data files.
8. Ballantyne et al. (US Patent No. 5,867,821) discloses a method and apparatus for electronically accessing and distributing personal health care information and services in hospitals and homes.
9. Non- Patent Literature: "A Web-Enabled FRAMEWORK for SMART CARD Application in Health Services"; Alvin T.S. Chan, Jiannong Cao, Henry Chan, and Gilbert Young; September 2001 ACM.
10. Anderson et al. (US 5,884,289).


***Points Of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna Colan whose telephone number is (571) 272-2752. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Giovanna Colan  
Examiner  
Art Unit 2162  
December 29, 2007

  
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